

REMARKS

Claims 1 to 52 were pending in the application at the time of examination. Claims 1 to 17 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 1 to 17, 19 to 34, 40, and 41 stand rejected under 35 U.S.C. §112, second paragraph. Claims 1 to 52 stand rejected as anticipated.

Claims 18 to 34 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner stated in part "Claims 18 to 34 are non-statutory because they are directed to a 'tool' without recitation of a computer or a computer readable-medium embodying the method in order to produce 'a useful, concrete and tangible result.'"

Applicant amended the preamble of Claims 18 to 34 to read "a computer-based tool." Applicant requests reconsideration and withdrawal of the §101 rejection of each of Claims 18 to 34.

Claims 1 to 52 stand rejected under 35 U.S.C. 102(b) as being anticipated by "Rogue Wave Software Online Documentation," Rogue Wave Software, Inc. 1999, hereinafter referred to as Rogue Wave.

Applicant respectfully traverses the anticipation rejection in view of Rogue Wave. The Examiner stated in part:

displaying a list of a plurality of computers, each computer of said plurality of computers having at least one environmental characteristic ("Select an environment . . . the Environment selection box shows only those environments for which configurations have been defined You can gain access to all supported environments by clicking the Show All Environments check box," Section 2.4.2.2

Applicant respectfully notes that in the Figure at the top of the page cited by the Examiner, the entry in the "Environment" box is "WIN95-MSVC 5.0." This is an entry in a

list of operating system and compiler pair environments and not a "list of a plurality of computers." Moreover, such a pair fails to teach any characteristics of a specific computer and instead described an operating system compiler pair that the library is compatible with. This fails to provide a list of computers that might include the WIN92-MSVC 5.0 environment or any of the other operating system and compiler pair environments that might be displayed in response to checking the Show All Environments box.

The fact that a library is built for a particular operating system and compiler pair environment as illustrated in the Figure of Rogue Wave fails to teach "The identical invention must be shown in as complete detail as is contained in the ... claim." Therefore, Rogue Wave fails to anticipate Claim 1. Moreover, the build configuration for a C++ library available for a selected code and selected environment that was cited by the Examiner are unrelated to designating a capable computer as recited in Claim 1. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 1 in view of Rogue Wave.

Claims 2 to 17 depend from Claim 1 and so distinguish over Smith for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 2 to 17 in view of Rogue Wave.

Claim 18 recites in part "a computer selector, responsive to the user's selection of a computer . . ." Claim 18 stands rejected under the same rationale as Claim 1. The above comments with respect to Claim 1 are incorporated herein by reference. In particular, the Examiner has failed to cite any teaching or suggestion of a computer selector, and moreover, as quoted above, Rogue Wave teaches a different tool that builds C++ library products. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 18.

Claims 19 to 34 depend from Claim 18 and so distinguish over Smith for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 19 to 34.

Claim 35 recites "means for designating a capable computer in response to the user's selection of a computer" Claim 35 stands rejected under the same rationale as Claim 1. The above comments with respect to Claim 1 are incorporated herein by reference. In particular, the Examiner has failed to cite any teaching or suggestion of this means. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 35.

Claims 36 to 51 depend from Claim 35 and so distinguish over Rogue Wave for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 36 to 51.

Claim 52 recites "designating a capable computer in response to the user's selection of a computer" Claim 52 stands rejected under the same rationale as Claim 1. The above comments with respect to Claim 1 are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 52.

Claims 1 to 52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0182650, hereinafter referred to as "Smith," in view of "Sun WorkShop TeamWare:User's Guide," Sun Microsystems, Inc. 1996, hereinafter referred to as "TeamWare."

Prior to considering the obviousness rejection, Applicant again respectfully submits that the Examiner has failed to establish that Smith is a proper reference. Smith is a continuation-in-part application that was filed on March 5, 2003, which is after Applicant's filing date of June 11, 2001.

It is well established that a continuation-in-part application has two filing dates. The Examiner has failed to demonstrate what new material was added to the March 5, 2003 filing of Smith, and which material was in the original filing of February 14, 2000. Thus, Smith is a proper reference only if the material relied upon by the Examiner was in the originally filed application of Smith. Any new material added by Smith in the March 5, 2003 filing cannot be relied upon by the Examiner as it is after Applicant's filing date. The Examiner has failed to demonstrate or even make an assertion that the material was in the original application of Smith. Accordingly, Applicant respectfully submits that at best the rejection is incomplete, and may in fact be improper. Applicant again requests that the Examiner cite with specificity the material relied upon by the Examiner in the proper document, i.e., U.S. Patent Application Serial No. 09/503,485, or remove the reference. Applicant also notes that this same request was made in the prior action based upon Smith.

To move the prosecution forward, Applicant will address the rejection. However, this is not to be construed as an admission by Applicant that Smith is a proper reference.

In an obviousness rejection, the MPEP requires:

PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

MPEP § 2141.02, 8th Ed., Rev. 2, pg 2100-127 (May 2004.)

In the rejection, the Examiner cited to page 7, lines 16-20 of Smith. These lines are in a "Introduction and Motivation" section, and at most describe build options. Smith also stated in the "Scope" section on page 7 starting at line 10:

Use of the model by a linker to detect and diagnose incompatibilities between differently built object modules.

Use of the model by a linker to choose the best:

- Variant of a library to link with from among a set of candidate variants.
- Library member from among a set of compatible members within a library.

Thus, Smith taught that a linker performs the library selector options. Further, Smith taught:

[0043] This source code 10, 12 together with the user selected build option parameters are supplied as inputs to a compiler 14 and an assembler 16 respectively.

Smith, paragraph [0043], page 2.

Smith further taught:

[0051] The groups of source code entities 18, 20 are supplied as one input to a linker 22. In relation to the mechanism of at least the preferred embodiments of this invention the linker 22 serves the function of identifying an appropriate library of machine code entities within a collection of libraries 24 and then matching the different source code entities to the appropriate machine code entities within the selected library. The output from the linker 22 is a machine code image 25 (group of machine code entities) that forms an executable program upon the target processor apparatus.

Smith, paragraph [0051], page 3.

As described in the above quotation from the MPEP, these teachings must be considered when interpreting

[0011] (ii) library selecting logic responsive to said library selector for selecting, from among a plurality of libraries of machine code entities, a selected library of machine code entities having a best level of execution environment requirements compatible with said limiting level of execution environment requirements indicated by said library selector;

Thus, when Smith is taken as a whole, Smith teaches that this piece of apparatus is performed by a linker. There has been no citation to any display in Smith, and the Examiner has not even asserted in this part of the rejection that Smith would be modified to provide:

displaying a list of at least one group of computer programs so as to allow a user to select a group of computer programs to be built, said at least one group of computer programs having a set of specific environmental requirements in which said at least one group of computer programs is to be compiled and executed

as recited in Claim 1. Since Smith teaches a selection process, as noted by the Examiner, other than that recited in the Claim 1, Smith teaches away from Applicant's invention, which is an indicium of non-obviousness.

In particular, Smith taught:

[0043] FIG. 1 illustrates the use of a software development tool system for forming machine code for a target processing apparatus from source code. A software developer may write a mixed program comprising some C or C++ source code 10 and some assembly language source code 12. This source code 10, 12 together with the user selected build option parameters are supplied as inputs to a compiler 14 and an assembler 16 respectively. If a user does not specify the build option parameters to be used with a particular source code object, then the compiler 14 or the assembler 16 may use its own default values for those particular build option parameters. (Emphasis added.)

Thus, Smith stated that the source code is written by the user which is used in the build. This further teaches away from Applicant's invention as quoted above from Claim 1 by stating a software developer wrote the code. Thus, no selection of computer code is necessary according to Smith. This

distinction alone is sufficient to overcome the obviousness rejection of Claim 1.

In the subsequent elements of Claim 1, the Examiner admits that Smith fails to teach or suggest any displaying, but argues that one of skill would combine unrelated parts of Teamware, in that the operations in Teamware are not part of linker, and would modify the linker operation of Smith to include the displays of Teamware.

The elements of the two references are at fundamentally different levels. As shown by Smith, the linker process is well after all user input has been provided, and so contrary to the rejection, there is no basis to provide displays associated with the linker. The Examiner has provided no prior art teaching that one of skill in the art would modify a linker to include displays and user selections from such displays. The fact that user input displays are used in a prior art reference does not provide a teaching or motivation to modify parts of Smith that are at a fundamentally different level from the level where the displays are used in the other prior art reference, and ignores that fact that Smith worked for its intended purpose without such displays.

Further, Smith taught the library selector cited by the Examiner is in the linker that uses lattice theory and compatibility (See pages 8 to 12 of Smith) to perform the operations cited by the Examiner. The Examiner has not explained how computer displays and computer selection input from such a display would or could be incorporated in the complex process of Smith or cited any teaching or suggestion that the complex process of Smith could be so modified.

Thus, Applicant respectfully submits that on multiple levels the combination of references is not well-founded. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 2 to 17 depend from Claim 1 and so distinguish over Smith for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 17.

Claim 18 recites in part "a computer selector, responsive to the user's selection of a computer . . ." Claim 18 stands rejected under the same rationale as Claim 1. The above comments with respect to Claim 1 are incorporated herein by reference. In particular, the Examiner has failed to cite any teaching or suggestion of a computer selector, and moreover, as quoted above, Smith alone or in combination with TeamWare teaches away from such a tool. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 18.

Claims 19 to 34 depend from Claim 18 and so distinguish over the combination of references for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 19 to 34.

Claim 35 recites "means for designating a capable computer in response to the user's selection of a computer" Claim 35 stands rejected under the same rationale as Claim 1. The above comments with respect to Claim 1 are incorporated herein by reference. In particular, the Examiner has failed to cite any teaching or suggestion of this means. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 35.

Claims 36 to 51 depend from Claim 35 and so distinguish over the combination of references for at least the same reasons as the claims upon which they depend. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 36 to 51.

Claim 52 recites "designating a capable computer in response to the user's selection of a computer"

Claim 52 stands rejected under the same rationale as Claim 1. The above comments with respect to Claim 1 are incorporated herein by reference. In particular, the Examiner has failed to cite any teaching or suggestion of this means. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 52.

Claims 1 to 52 remain in the application. Claims 18 to 34 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 22, 2005.

Respectfully submitted,



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March 22, 2005
Date of Signature